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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91200643
Party	Defendant Nowlan Family Trust
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Attachments	Response to Motion to Compel.pdf (17 pages)(647851 bytes)

TRADEMARK

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Trademark Opposition of:

Mark: BUCK ROGERS
Appln. No. 77/650082
Filed: January 15, 2009
Published: June 14, 2011

Opposition No.: 91200643

Date: July 3, 2012

Dille Family Trust,
Opposer

v.

Nowlan Family Trust,
Applicant

**APPLICANT, NOWLAN FAMILY TRUST'S RESPONSE IN OPPOSITION TO
OPPOSER'S MOTION TO COMPEL INITIAL DISCLOSURES**

I. Introduction

Applicant, Nowlan Family Trust ("Applicant"), hereby responds to Dille Family Trust's ("Opposer") motion to compel.

At the outset, Applicant notes that it is not entirely clear as to what relief Opposer is seeking as the motion itself is titled "Motion to Compel Initial Disclosures"; however, the motion itself does not mention or discuss any failure by

* * *
Certificate of Service and Mailing

I hereby certify that this correspondence is being filed online via ESTTA to: Trademark Trial and Appeal Board, P.O. Box 1451, Alexandria, VA 22313-1451, on July 3, 2012.

I further certify that this correspondence is being deposited with the U.S. Postal Service as First Class Mail in an envelope addressed to Vincent G. LoTempio, Kloss, Stenger & LoTempio, 69 Delaware Avenue, Suite 1002, Buffalo, NY 14202, on July 3, 2012.

7/3/12
Date of Signature
1988650-1

John J. O'Malley

Applicant to serve its Initial Disclosures.¹ Likewise, the body of the motion only refers to Opposer's First Set of Document Requests, but the remedy sought by Opposer is an order compelling response to Opposer's First Set of Document Requests *and* First Set of Interrogatories. However, Opposer's motion does not identify a single delinquent interrogatory response in the body of the motion.

Moreover, Applicant notes that pursuant to 37 C.F.R. 2.120 (e)(1), a motion to compel should include "a copy of the request for production, any proffer of production or objection to production in response to the request, and a list and brief description of the documents or things that were not produced for inspection and copying." The discovery requests and responses were not attached to the Opposer's motion, nor were the allegedly deficient document responses identified by number.

II. Background Facts

On January 18, 2012, Opposer served its first set of discovery requests which included interrogatories, requests for admission and requests for production of documents.

On February 22, 2012, counsel for Opposer consented to a 30 day extension of time to respond to the discovery requests.

On March 23, 2012, Applicant served its timely responses to Opposer's first set of discovery requests. Enclosed as Exhibit A are Applicant's Responses to Opposer's First Set of Document Requests.

Upon information and belief, in April 2012 Opposer filed a Writ of Summons

¹ Applicant notes that its Initial Disclosures were served on October 20, 2011.

in the Court of Commons Pleas of Lawrence County, Pennsylvania by which it instituted a civil action against Applicant, and its trustees and beneficiaries. To date, a complaint has not yet been served.

To date, Opposer has not served its Initial Disclosures which were due on October 20, 2011.

III. Argument

A. Opposer's Motion to Compel Should be Denied for Failure to Comply with the Relevant Discovery Rules and Regulations.

As noted above, Opposer has failed to comply with 37 C.F.R. 2.120 (e)(1), which requires that a motion to compel include “a copy of the request for production, any proffer of production or objection to production in response to the request, and a list and brief description of the documents or things that were not produced for inspection and copying.” The discovery requests and responses were not attached to the Opposer’s motion, nor were the allegedly deficient documents responses identified by number.

Moreover, Opposer has not served its Initial Disclosures which were due on October 20, 2011. Therefore, Opposer's motion to compel is improper because the original document requests were improper and the motion should be denied. See 37 C.F.R. 2.120(a)(3) and TBMP § 523.01.

For the foregoing reasons alone, Opposer's motions should be denied.

B. The Documents Sought By Opposer Are Not Relevant To The Proceedings And Production Of Such Documents Would Be Unreasonably Burdensome On Applicant.

Although Applicant believes that Opposer's motion to compel should be denied on procedural grounds, a review of the merits also supports denial of the motion.

As best can be ascertained from Opposer's confusing motion, Opposer is seeking productions of documents relating to the formation and assets of Applicant which is a trust. For the Board's convenience, Opposer's Request and applicant's responses from Exhibit A are reproduced below:

REQUEST NO. 6:

Any documents evidencing the legal formation of the Nowlan Family Trust.

RESPONSE: Nowlan objects to the request as overly broad, unduly burdensome and not reasonably calculated to lead to the discovery of admissible evidence. Nowlan further objects on the grounds that the request seeks information that is confidential, proprietary or protected by the attorney-client or work product privileges

REQUEST NO. 7:

Any documents describing the assets of the Nowlan Family Trust, and specifically those assets, if any, which relate to Applicant's Mark.

RESPONSE: Nowlan objects to the request as overly broad, unduly burdensome and not reasonably calculated to lead to the discovery of admissible evidence. Nowlan further objects on the grounds that the request seeks information that is confidential, proprietary or protected by the attorney-client or work product privileges.

Opposer stated in its motion that "[t]o date, said Opposer has not received

responses to these requests for production." See Opposer's Motion to Compel, ¶5. As the above cited responses and Exhibit A demonstrate, this statement is false. Applicant responded to the document requests in a timely manner with appropriate objections which Opposer's motion fails to address.

Regarding Request No. 6. which seeks documents relating to the formation of Applicant as a trust, there is no allegation in this case that Applicant is not a properly formed trust or any explanation as to why the documents are even relevant. If Applicant has concerns in that regard it can obtain the documents from the Commonwealth of Pennsylvania without burdening Opposer.

As to Request No. 7, which requests documents describing the assets of Applicant, Opposer has not explained why the assets of Applicant are relevant to this Opposition proceeding where damages are not at issue or why Applicant should be burdened by their production. Applicant's request is no different from asking an individual or a corporation to identify its assets. The TTAB would not grant such a request and should not do so in this case merely because Applicant is a trust rather than another type of entity.

Given the lack of relevance of the requests, it clearly appears that Opposer is merely using its TTAB discovery as a pretext for conducting a fishing expedition in support of its pending civil action in the Commonwealth of Pennsylvania. The TTAB should not countenance the abuse of the opposition discovery process.

IV. Conclusion

For all the foregoing reasons, Applicant respectfully requests that Opposer's Motion to Compel be denied.

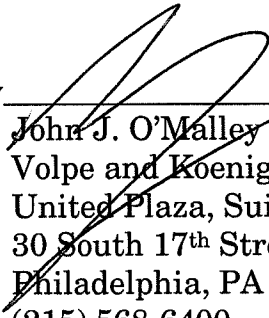
Respectfully submitted,

Nowlan Family Trust,

Date: _____

7/3/12

By _____


John J. O'Malley
Volpe and Koenig, P.C.
United Plaza, Suite 1600
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Attorney for Applicant

TRADEMARK

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Trademark Opposition of:

Mark: BUCK ROGERS
Appln. No. 77/650082
Filed: January 15, 2009
Published: June 14, 2011

Opposition No.: 91200643

Date: March 23, 2012

Dille Family Trust,
Opposer

v.

Nowlan Family Trust,
Applicant

**APPLICANT'S RESPONSES TO OPPOSER'S FIRST
SET OF DOCUMENT REQUESTS**

Applicant, Nowlan Family Trust ("Nowlan") by and through its attorneys, hereby responds to Opposer's, Dille Family Trust ("Dille") First Set of Document Requests as follows:

I. GENERAL OBJECTIONS

Nowlan objects to the requests in Dille's First Set of Document Requests on the following grounds and each General Objection is incorporated by reference to each response contained herein as though fully restated therein.

1. Nowlan objects to Dille's document requests to the extent that they seek confidential documents. Where indicated, such documents will be produced after entry of a protective order.

2. Nowlan objects to the requests because they are unbounded in time.

3. Nowlan objects to the requests to the extent that they request "any" document, which means all responsive documents, or they are unlimited as to time period. Such requests are overly broad and unduly burdensome.

4. Nowlan objects to Dille's definition of the term "documents" because it is overly broad and requires documents and things beyond the scope of Rule 34 of the Federal Rules of Civil Procedure.

II. RESPONSES TO REQUESTS

REQUEST NO. 1:

Any document referring, reflecting or relating to applications or other documents filed with the United States Patent and Trademark Office by Applicant for or related to trademark or service mark registrations in the United States for any variation of Opposer's Marks, either alone or in combination with any other words or symbols.

RESPONSE: Nowlan objects to the request as overly broad, unduly burdensome and not reasonably calculated to lead to the discovery of admissible evidence. Nowlan further objects on the grounds that the request seeks information that is confidential, proprietary or protected by the attorney-client or work product privileges. Without waiver and subject to the foregoing objections, Nowlan will produce responsive documents.

REQUEST NO. 2:

Any document referring or relating to dates of first use and first use in commerce in the United States by Applicant of Applicant's Mark on or in connection with Applicant's Products.

RESPONSE: Nowlan objects to the request as overly broad, unduly burdensome and not reasonably calculated to lead to the discovery of admissible evidence. Nowlan further objects on the grounds that the request seeks information that is confidential, proprietary or protected by the attorney-client or work product privileges. Without waiver and subject to the foregoing objections, Nowlan is not currently aware of the existence of any such documents.

REQUEST NO. 3:

Any document relating to Applicant's creation, consideration, design, development, selection, adoption, availability, and registration or attempts to register, both in the United States and abroad, of Applicant's Mark.

RESPONSE: Nowlan objects to the request as overly broad, unduly burdensome and not reasonably calculated to lead to the discovery of admissible evidence. Nowlan further objects on the grounds that the request seeks information that is confidential, proprietary or protected by the attorney-client or work product privileges. Without waiver and subject to the foregoing objections, Nowlan will produce responsive documents.

REQUEST NO. 4:

Any document relating to Applicant's decision to offer for sale goods and services under Applicant's Mark in the United States.

RESPONSE: Nowlan objects to the request as overly broad, unduly burdensome and not reasonably calculated to lead to the discovery of admissible evidence. Nowlan further objects on the grounds that the request seeks information that is confidential, proprietary or protected by the attorney-client or work product privileges.

REQUEST NO. 5:

Any document referring or relating to inter-party state or federal Trademark Office Proceedings, or inter-party state or federal court proceedings, in which Applicant's Mark is or was involved.

RESPONSE: Nowlan objects to the request as overly broad, unduly burdensome and not reasonably calculated to lead to the discovery of admissible evidence. Nowlan further objects on the grounds that the request seeks information that is confidential, proprietary or protected by the attorney-client or work product privileges. Without waiver and subject to the foregoing objections, Nowlan will produce responsive documents.

REQUEST NO. 6 [4]:

Each different advertisement, press release, catalog, brochure, point of purchase material, web page, training manual, or other advertising means or media in which Applicant's Mark has been used, is used, or will be used by Applicant in the United States.

RESPONSE: Nowlan objects to the request as overly broad, unduly burdensome and not reasonably calculated to lead to the discovery of admissible evidence. Without waiver and subject to the foregoing objections, Nowlan will

produce responsive documents. Without waiver and subject to the foregoing objections, Nowlan is not currently aware of the existence of any such documents.

REQUEST NO. 7 [5]:

Any document, contract, agreement, or other understanding, written and oral, between Applicant and any other entity concerning use of Applicant's Mark or variations thereof, including, but not limited to, all license, franchise, and distribution agreements with any other person or entity in the United States.

RESPONSE: Nowlan objects to the request as overly broad, unduly burdensome and not reasonably calculated to lead to the discovery of admissible evidence. Nowlan further objects on the grounds that the request seeks information that is confidential, proprietary or protected by the attorney-client or work product privileges.

REQUEST NO. 8 [6]:

Any documents evidencing the legal formation of the Nowlan Family Trust.

RESPONSE: Nowlan objects to the request as overly broad, unduly burdensome and not reasonably calculated to lead to the discovery of admissible evidence. Nowlan further objects on the grounds that the request seeks information that is confidential, proprietary or protected by the attorney-client or work product privileges.

REQUEST NO. 9 [7]:

Any documents describing the assets of the Nowlan Family Trust, and specifically those assets, if any, which relate to Applicant's Mark.

RESPONSE: Nowlan objects to the request as overly broad, unduly burdensome and not reasonably calculated to lead to the discovery of admissible evidence. Nowlan further objects on the grounds that the request seeks information that is confidential, proprietary or protected by the attorney-client or work product privileges.

REQUEST NO. 10 [8]:

Any document prepared or considered by any experts employed by Applicant in connection with his or her formation of an opinion concerning the subject matter of this Opposition.

RESPONSE: Nowlan objects to the request as overly broad, unduly burdensome and not reasonably calculated to lead to the discovery of admissible evidence. Nowlan further objects on the grounds that the request seeks information that is confidential, proprietary or protected by the attorney-client or work product privileges. Without waiver and subject to the foregoing objections, Nowlan is not currently aware of the existence of any such documents.

REQUEST NO. 11 [9]:

Any document identifying products or services sold or offered for sale under Applicant's Products.

RESPONSE: Nowlan objects to the request as overly broad, unduly burdensome and not reasonably calculated to lead to the discovery of admissible evidence. Nowlan further objects on the grounds that the request seeks information that is confidential, proprietary or protected by the attorney-client or work product

privileges. Without waiver and subject to the foregoing objections, Nowlan is not currently aware of the existence of any such documents.

REQUEST NO. 12 [10]:

Specimens of each label, tag, trade dress, or package used in connection with the offering of Applicant's Products.

RESPONSE: Nowlan objects to the request as overly broad, unduly burdensome and not reasonably calculated to lead to the discovery of admissible evidence. Nowlan further objects on the grounds that the request seeks information that is confidential, proprietary or protected by the attorney-client or work product privileges. Without waiver and subject to the foregoing objections, Nowlan is not currently aware of the existence of any such documents.

REQUEST NO. 13 [11]:

Any document that refers to, relates to or concerns the registrability of the mark BUCK ROGERS in the United States.

RESPONSE: Nowlan objects to the request as overly broad, unduly burdensome and not reasonably calculated to lead to the discovery of admissible evidence. Nowlan further objects on the grounds that the request seeks information that is confidential, proprietary or protected by the attorney-client or work product privileges. Without waiver and subject to the foregoing objections, Nowlan will produce responsive documents.

REQUEST NO. 14 [12]:

Any document that refers to or relates to Applicant's or Applicant's predecessors release or assignment of any rights to the name BUCK ROGERS to Opposer or Opposer's predecessors.

RESPONSE: Nowlan objects to the request as overly broad, unduly burdensome and not reasonably calculated to lead to the discovery of admissible evidence. Nowlan further objects on the grounds that the request seeks information that is confidential, proprietary or protected by the attorney-client or work product privileges. Without waiver and subject to the foregoing objections, Nowlan is not aware of any such documents.

REQUEST NO. 15 [13]:

Any document that refers to or relates to any license obtained by Applicant or any agent of the Applicant from the Dille Family Trust, Robert C. Dille, or John F. Dille.

RESPONSE: Nowlan objects to the request as overly broad, unduly burdensome and not reasonably calculated to lead to the discovery of admissible evidence. Nowlan further objects on the grounds that the request seeks information that is confidential, proprietary or protected by the attorney-client or work product privileges. Without waiver and subject to the foregoing objections, Nowlan is not aware of any such documents.

REQUEST NO. 16 [14]:

Any document that refers to or relates to a likelihood of confusion or instances or actual confusion from the use of Applicant's Mark.

RESPONSE: Nowlan objects to the request as overly broad, unduly burdensome and not reasonably calculated to lead to the discovery of admissible evidence. Nowlan further objects on the grounds that the request seeks information that is confidential, proprietary or protected by the attorney-client or work product privileges. Without waiver and subject to the foregoing objections, Nowlan is not currently aware of the existence of any such documents.

REQUEST NO. 17 [15]:

All documents referring or relating to the decision to file trademark application Serial No. 77/650,082.

RESPONSE: Nowlan objects to the request as overly broad, unduly burdensome and not reasonably calculated to lead to the discovery of admissible evidence. Nowlan further objects on the grounds that the request seeks information that is confidential, proprietary or protected by the attorney-client or work product privileges.

REQUEST NO. 18 [16]:

Any document not otherwise produced in accordance with a specific request herein which were identified by Applicant in its Answers to Opposer's Interrogatories Nos. 1-30.

RESPONSE: Nowlan objects to the request as overly broad, unduly burdensome and not reasonably calculated to lead to the discovery of admissible evidence. Nowlan further objects on the grounds that the request seeks information that is confidential, proprietary or protected by the attorney-client or work product

privileges. Without waiver and subject to the foregoing objections, Nowlan will produce responsive documents.

REQUEST NO. 19 [17]:

Any document Applicant now or hereafter intends to rely upon in this opposition proceeding.

RESPONSE: Nowlan objects to the request as overly broad, unduly burdensome and not reasonably calculated to lead to the discovery of admissible evidence. Nowlan further objects on the grounds that the request seeks information that is confidential, proprietary or protected by the attorney-client or work product privileges. Without waiver and subject to the foregoing objections, Nowlan will produce responsive documents.

Dated: 3/23/12

NOWLAN FAMILY TRUST

By 

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TRADEMARK

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Dille Family Trust,
Opposer

v.

Nowlan Family Trust,
Applicant

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of Applicant's Responses to Opposer's First Set of Document Requests were served on Opposer's Attorney of Record by electronic and first-class mail, postage pre-paid to the following:

Vincent G. LoTempio
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Buffalo, NY 14202
vglotempio@klosslaw.com

Date:

3/23/12

By:


John J. O'Malley, Esquire